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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,830	10/18/2001	Jun Tian	P0468	1787
23735	7590	09/14/2007		
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER PERUNGAVOOR, VENKATANARAY	
			ART UNIT 2132	PAPER NUMBER
			MAIL DATE 09/14/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/035,830

Applicant(s)

TIAN, JUN

Examiner

Venkat Perungavoor

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3, 6 and 10-45 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/8/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

1. The Applicant's arguments filed on 8/8/2007 are not persuasive with regard to Claims 1 and 4. And further, the Applicant's own admission that JPEG image compression allows for counterparts to original signal renders that limitation as obvious<sup>1</sup>. The specifications fails to disclose the counterparts of original signal being made, and subsequently a new matter rejection has been made.
2. The Applicant's argument with regard to Claim 5, 7-9 are persuasive. However, after an updated search the limitation was found in prior art that reads on it, the rejection herein.
3. The Applicant's amendments of Claim 3 and 6 make the claims allowable.

### ***Claim Rejections - 35 USC § 112***

4. Claim 1 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recites a counterpart of original first media signal, the recitation of counterpart is absent in the specifications.

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<sup>1</sup> See Remarks filed on 8/8/2007 page 11 Par. 006.

***New Matter Rejection***

5. Claim 1 and 4 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the specifications is as follows: The disclosure of counterpart is not present in the specifications.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6671407 to Venkatesan et al.(hereinafter Venkatesan).
8. Regarding Claim 1 and 4, Venkatesan discloses the compression of first image to generate compressed first media signal from which counterpart to the first signal can be later decompressed see Col 9 Ln 15-24 & see also Applicant *Remarks*(8/8/2007) see Page 11; embedding the compressed first media signal into the second media signal see Col 5 Ln 20-31; where the first and second

media signals are content objects and are perceptually similar<sup>2</sup> see Col 3 Ln 26-29 & Col 3 Ln 46-53(where the images are detected for piracy by comparing the hashes of images) & Col 4 Ln 47-58(where the watermarked images are compared for piracy).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6674874 to Yoshida et al.(hereinafter Yoshida) in view of US Patent Publication 2001/0051941 to Tonomura.

11. Regarding Claim 5 and 7, Yoshida discloses decoding the signal that is imperceptibly embedded into the signal see Col 15 Ln 11-24; comparing the hash value calculated with the value stored for authentication see Col 15 Ln 35-44; the embedding of hash values into host signal, where the hash is a function of image see Col 12 Ln 59- Col 13 Ln 15 & Col 13 Ln 49-65. But Yoshida does not decompressing of decoded signal. However, Tonomura discloses the decompressing of a decoded signal see Fig. 1 item 110. It would be obvious to

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<sup>2</sup> The term perceptually similar is being defined as the images having the same hash value see Specifications page 12 Ln 1.

one having ordinary skill in the art at the time of the invention to include the decompressing of a decoded signal in the invention of Yoshida in order to make matching, i.e. authentication easier as taught in Tonomura see Fig. 1 item 170.

12. Regarding Claims 8 and 9, Yoshida discloses the authentication of blocks using previous blocks see Col 12 Ln 40-54.

***Allowable Subject Matter***

13. Claims 3, 6, 10-45 are allowed as indicated in the previous action. The reasons for allowance will not be repeated here for sake of brevity.

***Conclusion***


14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkat Perungavoor whose telephone number is 571-272-7213. The examiner can normally be reached on 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VP/  
Venkat Perungavoor  
Examiner  
Art Unit 2132  
September 10, 2007

  
GILBERTO BARRON JR  
SUPERVISORY PATENT EXAMINER  
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